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In re application of
Christopher T. Evans
Application No. 10/734,587
Filed: December 15, 2003
For: SINGLE DISPENSING FILM
STRIP CONTAINER

TECHNOLOGY CENTER 3600
: **DECISION ON PETITION**
: **REGARDING REQUEST TO**
: **WITHDRAW FINALITY**
: **UNDER 37 CFR 1.181**

This is in response to applicant's petition filed under 37 CFR 1.181 filed April 26, 2007 requesting withdrawal of finality of the Office action mailed April 20, 2007 as being premature.

The Petition is **GRANTED**.

Applicant alleges that the final rejection mailed April 20, 2007 is premature because the citation of a new reference, Krzyzanowski, was not necessitated by amendment of the claims.

MPEP 706.07(a) sets forth that the second or any subsequent action on the merits shall be made final except where the examiner introduces a new ground of rejection that is neither necessitated by applicants' amendment nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR .97(c) with the fee set forth in 37 CFR 1.17(p).

A summary of the examiner's Office actions and of applicant's responses is as follows:

1. A first office action was mailed July 26, 2006 rejecting claims 1-10 and 15-17 under 35 USC 112, claims 1-4 under 35 USC 102(b) over Leopoldi, claims 5-10, 15-17 and 20 under 35 USC 103 over Leopoldi in view of Pollock. Furthermore, claim 1 was rejected under 35 U.S.C. 112, second paragraph, for being unclear, as to whether "a tip of the extension" recited in line 4 of claim 1 was the same as "the extension tip" recited later in the claim. Further, on page 4 of the office action, the examiner stated that the claims would be construed as the limitations referring to the same extension tip.

2. Applicant's response filed October 26, 2006, amended claim 1 to clarify that the limitations to "a tip of the extension" and "the extension tip" were in fact the same element and argued the propriety of the art rejections.

3. A second, final office action was mailed February 27, 2007, rejecting claims 1-10, 15-17 and 20 under 103 over Leopoldi in view of Pollack.

4. On April 3, 2007 applicant filed a petition requesting withdrawal of the finality of the final rejection mailed February 27, 2007. The petition was mistakenly treated as an after final amendment/request for reconsideration.

5. Because of this mistake, a third, final office action was mailed on April 20, 2007, clarifying and correcting mistakes in the rejection preamble of the action mailed February 27, 2007, rejecting claims 1-10, 15-17 and 20 under 103 over Kryzyzanowski in view of Pollack.

In the instant petition the applicant contends the claims were prematurely finally rejected because the citation of Kryzyzanowski was not necessitated by amendment to the claims.

After careful review of the above facts, applicant's amendment of claim 1 in the response filed October 26, 2006, merely amends the claim to include limitations or clarify limitations that would have reasonably been expected to be claimed in response to the examiners' 112 indefiniteness rejection. Furthermore, the examiner stated in the first office action that the claims were being interpreted in a manner consistent with applicant's subsequent amendment to the claims. Applicant's amendment of claim 1 neither changed the scope of the claims nor the examiner's interpretation of the claims.

Hence applicant's petition to withdraw the finality of the Office action mailed April 20, 2007 is **GRANTED**.

Accordingly, the finality of the Office action mailed April 20, 2007, but not the action itself, is hereby vacated. The response filed July 20, 2007 will be entered and forwarded to the examiner for consideration of the amendment.

Inquiries related to this decision may be directed to Supervisory Patent Examiner Gene O. Crawford at (571) 272-6911.



Katherine Matecki
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Technology Center 3600
[KD/GC: 7/25/07]